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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/532,567	04/22/2005	Stefano Donadio	892,280-553	6732

28523 7590 02/23/2009
PFIZER INC.
PATENT DEPARTMENT, MS8260-1611
EASTERN POINT ROAD
GROTON, CT 06340

EXAMINER

KAM, CHIH MIN

ART UNIT	PAPER NUMBER
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1656

NOTIFICATION DATE	DELIVERY MODE
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02/23/2009

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

~IPGSGro@pfizer.com

Office Action Summary	Application No. 10/532,567	Applicant(s) DONADIO ET AL.	
	Examiner CHIH-MIN KAM	Art Unit 1656	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15, 17, 18, 21, 24, 25, 27 and 28 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-15, 17, 18, 21, 24, 25, 27 and 28 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

1. In the preliminary amendment filed April 22, 2005, claims 1-15, 17, 18, 21, 25, 27 and 28 have been amended, and claims 16, 19, 20, 22, 23, 26 and 29 have been cancelled. Therefore, claims 1-15, 17, 18, 21, 24, 25, 27 and 28 are pending.

Election/Restrictions

2. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in response to this action, to elect a single invention to which the claims must be restricted.

Group I, claims 1-15, 17, 18 and 21, drawn to an isolated nucleic acid comprising a nucleotide sequence of the *dbv* gene cluster (SEQ ID NO:1) encoding the polypeptides required for the synthesis of A40926, a nucleotide sequence encoding the same polypeptide other than the *dbv* gene cluster, a nucleotide sequence of *dbv* ORFs 1-37 encoding a polypeptide of SEQ ID NOs:2-38, or a nucleotide sequence encoding any polypeptide of SEQ ID NOs:2-38 other than *dbv* ORFs 1-37; a recombinant vector comprising the DNA sequence; and a method for increasing production of A40926 by a microorganism using the recombinant vector.

Group II, claims 24-25, drawn to a transformed A40926-producing microorganism having A40926 biosynthetic genes in its genome wherein at least one of the A40926 biosynthetic genes of *dbv* ORFs 1-37 is disrupted.

Group III, claim 27, drawn to a method of producing a glycopeptide different from A40296 or precursor thereof.

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Group IV, claim 28, drawn to an isolated polypeptide involved in the biosynthetic pathway of A40926, comprising an ORF polypeptide (SEQ ID NO: 2-38) encoded by any of *dbv* ORFs 1-37, or an ORF polypeptide variant.

The claims of these groups are directed to different inventions, which are not linked to form a single general concept. The claims in the different groups do not have in common the same or corresponding technical features. In particular, each group is directed to distinct chemical entities (i.e., nucleic acid, modified A40926-producing microorganism, and polypeptide), and/or methods which use different materials and produce different effects. For examples, polypeptides and polynucleotides, which have different structures and utilities, are patentably distinct. Accordingly, the claims are not so linked by a special technical feature within the meaning of PCT Rule 13.2 so as to form a single inventive concept and lack of unity is deemed proper.

Insofar as Groups I-IV are directed to nucleic acids, modified A40926-producing microorganisms, polypeptides, and a method for producing a glycopeptides different from A40926 or a precursor thereof, each is defined by a sequence of amino acids and nucleotides that is independent and/or patentably distinct, one from the other.

Should Group I be elected, applicant is required to select “one” amino acid sequence from SEQ ID NOs: 2-38 (cited in claims 1-13 and 15) and the corresponding *dbv* ORFs 1-37.

Should Group II be elected, applicant is required to select “one” amino acid sequence from SEQ ID NOs: 2-38 (cited in claim 24) and the corresponding *dbv* ORFs 1-37.

Should Group IV be elected, applicant is required to select “one” amino acid sequence from SEQ ID NOs: 2-38 (cited in claim 28) and the corresponding *dbv* ORFs 1-37.

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Each nucleic acid or polypeptide sequence, which contains different nucleotide or amino acid sequence, is patentably distinct. This is not species election.

Restriction for examination purposes as indicated is proper because all these inventions listed in this action are independent or distinct for the reasons given above and there would be a serious search and examination burden if restriction were not required because one or more of the following reasons apply:

- (a) the inventions have acquired a separate status in the art in view of their different classification;
- (b) the inventions have acquired a separate status in the art due to their recognized divergent subject matter;
- (c) the inventions require a different field of search (for example, searching different classes/subclasses or electronic resources, or employing different search queries);
- (d) the prior art applicable to one invention would not likely be applicable to another invention;
- (e) the inventions are likely to raise different non-prior art issues under 35 U.S.C. 101 and/or 35 U.S.C. 112, first paragraph.

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a invention to be examined even though the requirement may be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically

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point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse. Traversal must be presented at the time of election in order to be considered timely. Failure to timely traverse the requirement will result in the loss of right to petition under 37 CFR 1.144. If claims are added after the election, applicant must indicate which of these claims are readable on the elected invention.

If claims are added after the election, applicant must indicate which of these claims are readable upon the elected invention.

Should applicant traverse on the ground that the inventions are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chih-Min Kam whose telephone number is (571) 272-0948. The examiner can normally be reached on 8.00-4:30, Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jon Weber can be reached at 571-272-0925. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Chih-Min Kam/

Primary Examiner, Art Unit 1656

CMK

February 13, 2009